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In re Application of	:	
Christensen et al	:	
Application No.: 09/806,563	:	
PCT Application No.: PCT/DE99/03101	:	DECISION ON
International Filing Date: 28 February 2001	:	
Priority Date: 30 September 1998	:	PETITION UNDER
Attorney Docket No.: 112740-201	:	
For: METHOD TO TESTING	:	37 CFR 1.47 (a)
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This is in response to applicants' "PETITION TO PERMIT FILING UNDER" under 37 CFR 1.47 (a), filed on 19 April 2004.

### BACKGROUND

On 27 September 1999, applicant filed international application number PCT/DE99/03101 which claimed priority to an earlier filed German application filed on 30 September 1998.

On 30 March 2001 applicants filed a submission to enter the national stage application under 35 USC 371.

On 17 November 2003, the United States Patent and Trademark Office issued a Notification of Missing Requirements, requiring an Oath or Declaration in compliance with 37 CFR 1.497 (a) and (b).

On 19 April 2004, applicants submitted a response to the Notification of Missing Requirements along with a petition for a three month extension of time under 37 CFR 1.136 (a). The response consists of "PETITION TO PERMIT FILING UNDER 37 CFR 1.47 (a)", along with a newly executed declaration and power of attorney.

### DISCUSSION

A petition pursuant to 37 CFR 1.47 (a) to accept the application without the signature of one of the joint inventors must include: 1) an oath or declaration signed by all available joint

inventors on their own behalf and on behalf of the non-signing inventor; 2) proof that the non-signing inventor refuses to join in an application for patent or cannot be found or reached after diligent effort; 3) the petition fee; and 4) the last known address of the non-signing inventor.

Petitioners have satisfied items (3) and (4).

With regard to item (1), the declaration submitted 19 April 2004, is not in compliance with 37 CFR 1.497. The declaration comprises three "page 4" s, each executed by a different inventor. Applicants must submit the complete original declaration (or a complete copy thereof) of each separately executed declaration. Applicants cannot merely piecemeal pages of separately executed declarations into a single composite declaration.

With regard to item (2), the petition does not include sufficient proof that the non-signing inventor refuses to sign. The proffered evidence consists of an a declaration by Desiree Gobel, employee of Siemens AG, the assignee of the international application, stating that a copy of the application has been sent to Svend Christensen on three separate occasions requesting signature, specifically on March 27, 2001, December 5, 2003 and February 2, 2004. As stated in the declaration by Desiree Gobel, "On February 02, 2004 I telephoned Mr. Christensen and he indicated the he needed the documents sent to him by fax and by email. In response to Mr. Christensen's request, I faxed and emailed the documents to him the same day. A copy of this email is included herewith as evidentiary support of this communication. Mr. Christensen informed me that he refuses it sign these documents". Applicants failed to provide a copy of email communications between applicants and nonsigning inventor, secondly there is no details about the alleged express oral refusal (e.g. no specific time or date of the refusal), and thirdly no document of evidence of receipt of the completed copy of the application (the fact that Mr. Christensen indicated on 02 February 2004 that he needed the documents suggests that the earlier delivery attempts were not successful).

Attention is directed to MPEP 409.03(d), which provides in part:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the non-signing inventor's attorney. Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts.

For the above reasons, it would not be appropriate to grant the petition under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition to permit filing under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47 (a)." No petition fee is due. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, USA and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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